

## **REMARKS**

### **A. The claims are not anticipated under 35 U.S.C. §102(b)**

Claims 1 - 4, 6, 13 - 16, 18, 25, 26, 28, 30, 31, 33 and 35 stand rejected under 35 U.S.C. §102(b) as being anticipated by Banknieder et al., U.S. Patent 4,751,243.

The Action states that the Banknieder reference is asserted in support of this rejection because, despite the fact acknowledged in the Action that Banknieder teaches systemic administration of the aldose reductase inhibitor, tolrestat (the compound N-[[5-(trifluoromethyl)-6-methoxy-1-naphthenyl]-thioxomethyl]-N-methylglycine), the wound will be "contacted" by the compound as a result of systemic distribution of the compound. Although Applicants disagree with this interpretation, they have amended the pending claims to recite that the wound is exposed to an aldose reductase inhibitor compound by *topical* application of the compound to the wound.

Applicants respectfully submit that the term "topical" when used to describe a mode of administration of a pharmaceutically active substance would be understood in the art to be in contradistinction to systemic administration, as evidenced by the following definition:

Topical [adj] (medicine) pertaining to the surface of a body part; "a drug for topical (or local) application"; "a topical anesthesia".  
<http://www.hyperdictionary.com/dictionary/topical> (visited January 28, 2005)

Applicants respectfully contend that this amendment fully addresses the bases for the rejection under 35 U.S.C. §102(b), and respectfully ask the Examiner to withdraw the rejection.

### **B. The claims are not obvious under 35 U.S.C. §103(a)**

Claims 1-4, 6-7, 13-16, 18-19, 25-26, 28-31, 33-34 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Banknieder et al.

Applicants respectfully contend that the deficiencies of the Banknieder reference set forth above apply with equal force to the rejection based on obviousness. The amendments Applicants submit herewith to the claims sufficiently distinguish the instantly claimed invention from the teachings of the Banknieder reference, because on having ordinary skill in the art would appreciate the differences between drug administered systemically and drugs

administered topically, which differ *inter alia* in type, formulation, excipients, concentration or active ingredient, Applicants thus respectfully ask the Examiner to withdraw this ground or rejection.

### **CONCLUSIONS**

It is believed that all requirements of patentability are fully met, and allowance of the claims is respectfully requested.

If the Examiner believes it to be helpful, the Examiner is invited to contact the undersigned attorney by telephone at (312) 913-0001.

Respectfully submitted,  
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